PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Vikram Swamy et al.	Examiner: Seng H. Lim
Serial No.: 10/562,411	Group Art Unit: 3714
Filed: March 19, 2007	Docket: 1842.019US1

For: GAMING NETWORK ENVIRONMENT PROVIDING A CASHLESS GAMING SERVICE

APPEAL BRIEF UNDER 37 CFR § 41.37

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Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 17, 2009, from the Final Rejection of claims 1-5, 7-27 and 29-44 of the above-identified application, as set forth in the Final Office Action mailed on November 17, 2008.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of $540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, WMS GAMING INC..

2. RELATED APPEALS AND INTERFERENCES

The following patent applications are related to the above-identified application, are currently appealed to the Board, and may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. No decisions have been rendered by the Board as of the filing of this Appeal Brief.

App. Serial #	Attorney Docket	Title
10/813,653	1842.017US1	EVENT MANAGEMENT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
11/068,065	1842.018US2	GAMING NETWORK ENVIRONMENT HAVING A LANGUAGE TRANSLATION SERVICE
10/788,903	1842.020US1	A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/788,661	1842.021US1	GAMING MANAGEMENT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/788,902	1842.022US1	GAME UPDATE SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/789,957	1842.023US1	PROGRESSIVE SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/794,723	1842.024US1	DISCOVERY SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/794,422	1842.025US1	BOOT SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/796,553	1842.026US1	AUTHENTICATION SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/796,562	1842.027US1	AUTHORIZATION SERVICE IN A SERVICE-ORIENTED GAMING NETWORK
10/802,700	1842.028US1	NAME SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/802,701	1842.029US1	TIME SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT
10/802,699	1842.030US1	ACCOUNTING SERVICE IN A SERVICE ORIENTED GAMING NETWORK ENVIRONMENT
10/802,537	1842.031US1	MESSAGE DIRECTOR SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT

3. STATUS OF THE CLAIMS

The present application was filed on December 23, 2005 with claims 1-44. A non-final Office Action mailed May 12, 2008 rejected claims 1-44. Claims 6 and 28 were canceled in a response to the non-final Office Action filed on August 12, 2008. A Final Office Action (hereinafter "the Final Office Action") was mailed November 17, 2008 rejecting claims 1-5, 7-27 and 29-44. Pending claims 1-5, 7-27 and 29-44 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated November 17. 2008.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, systems and methods that provide a cashless gaming service in a service-oriented gaming network environment. In general, the independent claims recite systems and methods that provide a three party handshake for providing a cashless gaming service on a wagering game network. The a cashless gaming service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the cashless gaming service and in response publishes the service information, and a client such as a wagering game machine desiring to use the cashless gaming service obtains the service information from the discovery agent and uses the service information to contact and utilize the cashless gaming service.

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal . . .." Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

INDEPENDENT CLAIM 1

1. A method for providing a cashless gaming service in a gaming network including gaming machines, the method comprising:

sending service information for the cashless gaming service from the cashless gaming service to a discovery agent on the gaming network, wherein the cashless gaming service provides electronic funds transfer for one or more of a plurality of gaming machines on the gaming network, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game; *[see e.g., FIGs. 1-2, element 10; FIG. 3, elements 302 and 304; FIG. 5B, elements 501, 502, 503 and 521; FIG. 6, element 601; page 5, line 10 to page 6, line 18; page 7, lines 11-17; page 18, line 9 to page 19, line 14; and page 24, lines 4-5]*

determining by the discovery agent if the cashless gaming service is authentic and authorized; *[see e.g., FIG. 5B, elements 502, 503, 522 and 523; page 7, line 27 to page 8, line 3; page 15, line 19 to page 16, line 8; and page 24, lines 6-11]*

in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network; *[see e.g., FIG. 3, elements 324 and 326; FIG. 5B, element 524; page 12, lines 4-16; and page 24, lines 12-15]*

receiving by the discovery agent a discovery request for the location of the cashless gaming service from a gaming client on a gaming machine of the plurality of gaming machines; *[see e.g., FIG. 3, elements 302, 306, 312, 326 and 332; FIG. 5B, element 525; page 12, lines 4-16; and page 24, lines 16-17]*

using the service information for the cashless gaming service to register the gaming client with the cashless gaming service; *[see e.g., FIG. 3, elements 302, 304, 306, 312, 326, 332 and 334; FIG. 5B, elements 526, 527, 528 and 530; page 12, lines 4-16; page 17, lines 8-15; and page 24, line 18 to page 25, line 2]*

verifying that the gaming client is authorized to utilize the cashless gaming service; and *[see e.g., FIG. 2, element 232; FIG. 5B, elements 531-533; page 6, line 25 to page 7, line 2; page 25, lines 3-10]*

processing one or more service requests between the gaming client and the cashless gaming service, said service requests conforming to an internetworking protocol. *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 4, element 400; FIG. 5B, elements 535-538; page 12, line 25 to page 14, line 10; page 17, lines 8-15; and page 25, line 15 to page 26, line 2]*

INDEPENDENT CLAIM 23

23. A gaming network system, the gaming network system comprising:

a plurality of gaming machines communicably coupled to the gaming network, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game; *[see e.g., FIGs. 1-2, element 10; FIG. 5B, element 501; FIG. 6, element 601; and page 5, line 10 to page 6, line 18; and page 7, lines 11-17;]*

a cashless gaming service communicably coupled to the gaming network and operable to provide electronic funds transfer for the plurality of gaming machines on the gaming network, *[see e.g., FIG. 3, element 304; FIG. 5B, element 502; FIG. 6, element 602, 603; page 11, lines 21-29; and page 18, line 9 to page 19, line 14]*

a discovery agent communicably coupled to the gaming network, wherein the discovery agent is operable to: *[see e.g., FIG. 3, element 306; and page 12, lines 4-16]*

receive service information from the cashless gaming service, *[see e.g., FIG. 3, elements 304, 322 and 330; FIG. 5B, element 521; page 12, lines 4-16; and page 24, lines 4-5]*

determine if the cashless gaming service is authentic and authorized for the gaming network, and *[see e.g., FIG. 5B, elements 502, 503, 522 and 523; page 7, line 27 to page 8, line 3; page 15, line 19 to page 16, line 8; and page 24, lines 4-11]*

publish the service information to a service repository to make the cashless gaming service available on the gaming network; *[see e.g., FIG. 3, elements 324 and 326; FIG. 5B, element 524; page 12, lines 4-16; and page 24, lines 12-15]*

wherein at least one gaming client on a gaming machine of the plurality of gaming machines communicably coupled to the gaming network is operable to issue a request for the location of the cashless gaming service to the discovery agent and use the service information received from the discovery agent to issue a registration request to the cashless gaming service; and *[see e.g., FIG. 3, elements 302, 304, 306, 312, 326, 332 and 334; FIG. 5B, elements 525-528 and 530; page 12, lines 4-16; page 17, lines 8-15; and page 24, line 16 to page 25, line 2]*

further wherein the cashless gaming service is further operable to:

receive the registration request from the gaming client; and *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 5B, elements 530-533; page 17, lines 8-15; and page 25, lines 1-10]*

process one or more service requests between the gaming client and the cashless gaming service, said service requests conforming to an internetworking protocol. *[see e.g., FIG. 3, elements 302, 304 and 334; FIG. 4, element 400; FIG. 5B, elements 535-538; page 12, line 25 to page 14, line 10; page 17, lines 8-15; and page 25, line 15 to page 26, line 2]*

DEPENDENT CLAIMS 3-4 AND 25-26

3. The method of claim 2, wherein the service request is formatted according to a service description language. *[see e.g., FIG. 4, element 417; page 13, line 28-page 14, line 10; and page 17, lines 8-15]*

4. The method of claim 3, wherein the service description language is a Web Services Description Language (WSDL). *[see e.g., FIG. 4, element 417; page 13, line 28-page 14, line 10; and page 17, lines 8-15]*

25. The gaming network system of claim 23, wherein the service request is formatted according to a service description language. *[see e.g., FIG. 4, element 417; page 13, line 28-page 14, line 10; and page 17, lines 8-15]*

26. The gaming network system of claim 25, wherein the service description language is a Web Services Description Language (WSDL). *[see e.g., FIG. 4, element 417; page 13, line 28-page 14, line 10; and page 17, lines 8-15]*

DEPENDENT CLAIMS 5 AND 27

5. The method of claim 2, wherein the cashless gaming service is registered in a UDDI registry. *[see e.g., FIG. 4, element 418; FIG. 5B, element 521; page 13, line 28-page 14, line 19; page 15, line 5 to page 16, line 8; and page 24, lines 4-5]*

27. The gaming network system of claim 23, wherein the cashless gaming service is registered in a UDDI registry. *[see e.g., FIG. 4, element 418; FIG. 5B, element 521; page 13, line 28-page 14, line 19; page 15, line 5 to page 16, line 8; and page 24, lines 4-5]*

DEPENDENT CLAIMS 8 AND 30

8. The method of claim 1, wherein the service request comprises an HTTP request encapsulating an OFX message. *[see e.g., FIG. 5B, element 516; FIG. 6, element 522; page 20, line 23 to page 21, line 6; and page 26, lines 17-22]*

30. The gaming network system of claim 23, wherein the service request comprises an HTTP request encapsulating an OFX message. *[see e.g., FIG. 5B, element 516; FIG. 6, element 522; page 20, line 23 to page 21, line 6; and page 26, lines 17-22]*

DEPENDENT CLAIM 44

44. The gaming network system of claim 43, wherein the authentication service includes a LDAP authentication service. *[see e.g., FIG. 4, element 412, FIG. 5B, elements 522 and 523; page 12, line 25 to page 13, line 7; and page 24, lines 6-11]*

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 3-5, 8, 25-27, 30 and 44 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Claims 1-5, 7, 9-12, 22-27, 29, 31-40 and 43 were rejected under 35 U.S.C. § 102(b) for anticipation by Gatto et al. (U.S. Patent No. 6,916,247 B2; hereinafter "Gatto").

Claims 8, 14, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23.

Claims 15-17 and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23 in view of Letovsky et al. (U.S. Publication No. 2002/0147047 A1; hereinafter "Letovsky").

Claims 20-21 and 41-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23 in view of Oberberger et al. (U.S. Publication No. 2002/0077178 A1; hereinafter "Oberberger").

Claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claim 43 taken with Bowman-Amuah (U.S. Patent No. 6,289,382 B1).

7. ARGUMENT

A) The Rejection of Claims 3-5, 8, 25-27, 30 and 44 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 112, second paragraph states "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Thus, the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The Board of Patent Appeals and Interferences has stated:

> In rejecting a claim under the second paragraph of 35 U.S.C.§112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte* Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989)(citing *In re* Moore, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971); *In re* Hammack, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970)).

The M.P.E.P. adopts this line of reasoning, stating that:

> The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
>
> (A) The content of the particular application disclosure;
> (B) The teachings of the prior art; and
> (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *M.P.E.P.* § 2173.02.

The only reasoning provided in the Final Office Action's rejection of 3-5, 8, 25-27, 30 and 44 as being indefinite is "Web service protocols are subject to change over time without notice and are therefore not definite." Even if true, the mere possibility of change over time is not sufficient to support an argument that a claim is indefinite. If such an argument were valid, every claim could be rejected, because the meaning of almost any word may change over time. For example, the verb "surf" in the not too distant past meant riding a surfboard. Now almost

anyone would agree that the meaning of the verb "surf" has changed to include searching or browsing the internet or television channels for content of interest to the "surfer."

Additionally, the claims must be analyzed in light of the content of the application disclosure. Appellant respectfully submits that the claim language in question, when analyzed in light of the content of the application disclosure, is not indefinite. For example, with respect to claims 3-4 and 25-26, the application disclosure provides a description of a service description language, using WSDL (Web Services Description Language) as an example (see e.g., FIG. 4, element 417; page 13, line 28-page 14, line 10; and page 17, lines 8-15). With respect to claims 5 and 27, the application disclosure provides a description of a UDDI registry and registering a cashless gaming service in a UDDI registry in FIG. 4, element 418; FIG. 5B, element 521; and at page 13, line 28-page 14, line 19; page 15, line 5 to page 16, line 8; and page 24, lines 4-5. With respect to claims 8 and 30, the application disclosure, in FIG. 5B, element 516; FIG. 6, element 522; and at page 20, line 23 to page 21, line 6; and page 26, lines 17-22 provides a description of the use of HTTP and OFX as recited in the claims. Finally, with respect to claim 44, the use of LDAP as an authentication service is described in FIG. 4, element 412, FIG. 5B, elements 522 and 523; and at page 12, line 25 to page 13, line 7; and page 24, lines 6-11. In view of the description in the application disclosure, the elements recited in claims 3-5, 8, 25-27, 30 and 44 are definite.

Even assuming that Web service protocols are subject to change over time, one possessing the ordinary level of skill in the pertinent art at the time the invention was made would be able to interpret the claims. For example, one of ordinary skill in the art would be able use protocol specifications and definitions available at the time of the application filing to determine the meaning of WSDL, LDAP, HTTP and OFX. Thus, one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, is in fact able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by claims 3-5, 8, 25-27, 30 and 44. Thus claims 3-5, 8, 25-27, 30 and 44 are not indefinite.

For all of the reasons set forth above, Appellant respectfully requests reversal of the claim rejections under 35 USC 112.

B) The Rejection of Claims 1-5, 7, 9-12, 22-27, 29, 31-40 and 43 under 35 U.S.C. § 102(b) for anticipation by Gatto

i.) The Applicable Law under 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P § 2131.* To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

ii.) The Application of 35 U.S.C. § 102 to the Rejected Claims

Claims 1-5, 7, 9-12, 22-27, 29, 31-40 and 43 were rejected under 35 U.S.C. § 102(b) for anticipation by Gatto. This rejection is respectfully traversed. Appellant respectfully submits that the Final Office Action has made an improper *prima facie* showing of anticipation at least because the claims contain elements not found in Gatto.

For example, claim 1 recites "sending service information for the cashless gaming service from the cashless gaming service to a discovery agent on the gaming network." Claim 23 recites similar language. The Final Office Action states that Gatto, in FIGs. 19 and 20 and at column 14, lines 11-33 discloses "sending service information for a service from the gaming service (specialized device) to a discovery agent (server, 112) on the gaming network." Appellant

respectfully disagrees with this interpretation of Gatto. The cited section of Gatto discloses that a central server can subscribe to asynchronous events causing the specialized device to notify the central service of events specified as being of interest to the server. However, this is different from Appellant's claims 1 and 23 for several reasons. First, Gatto refers to communication between a device and a central server. A device is not a service. Second, there is no disclosure of the device, or any other component of Gatto, sending service information to a discovery agent. While Gatto mentions the use of UDDI, Gatto is silent as to how the information is provided to a UDDI node in order to be published. It is neither inherent nor necessary that a service provide service information to a discovery agent. For example, one way known in the art is for a user to provide service information to a discovery agent using a user interface to provide configuration details or to direct the discovery agent to read configuration from a file. Gatto does not disclose any specific mechanism for a discovery agent to obtain service information, thus Gatto does not teach or suggest "sending service information for the cashless gaming service from the cashless gaming service to a discovery agent on the gaming network" as recited in claim 1 and similarly recited in claim 23.

Further, claim 1 recites "determining by the discovery agent if the cashless gaming service is authentic and authorized" and further recites that "in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network." Claim 23 recites similar language with respect to a discovery agent authenticating and authorizing a cashless gaming service using a response from an authorization service. The Final Office Action asserts that Gatto, at column 10, lines 55-62 discloses "determining by the discovery agent if the cashless gaming service is authentic and authorized using an authentication engine." Appellant respectfully disagrees with this interpretation of Gatto for several reasons detailed below. The portion of Gatto cited in the Final Office Action discloses the following. Gatto, at column 10, lines 55-63 discloses "[t]he authentication engine 834 may include functionality to consult a Certificate Authority (which may be located on a server on the network 102 or on a computer network connected thereto), certify the authenticity of the identification presented, authorize a given operation, ensure data integrity of data exchanged, securely time-stamp the operation (to ensure non-repudiation of the operation) and/or revoke illegal identifications, for example." The

cited section indicates that an authentication engine may be used to authenticate identities (presumably of player identification means) or to authorize operations. There is no disclosure of authentication of a service, and further there is no disclosure of authorization of a service. The actions performed by the authentication engine 834 cited above would all occur after a service has been instantiated (e.g., the player identification and operations of that may be performed by a service). In contrast, Appellant's claims recite a system and method in which a cashless gaming service is not allowed to be published on a gaming network unless it is authentic and authorized. Such an arrangement provides the advantage that services must be authenticated and authorized before being published on the network, thereby reducing the potential that a service may engage in harmful actions on a gaming network.

In view of the above, neither column 10, lines 55-62, nor any other portion of Gatto discloses determining by a discovery agent if a cashless gaming service is authentic and authorized as recited in claims 1 and 23. Additionally, Gatto fails to disclose publishing the service information to a service repository to make a cashless gaming service available on the gaming network as recited in claims 1 and 23.

For the reasons discussed above, claims 1 and 23 recite multiple elements that are not disclosed in Gatto. As a result, claims 1 and 23 are not anticipated by Gatto. Appellant respectfully requests reversal of the rejection of claims 1 and 23.

Claims 2-5, 7, 9-12 and 22 depend from claim 1 and claims 24-27, 29, 31-40 and 43 depend from claim 23. These dependent claims inherit the elements of their respective base claims, including elements directed to sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; and in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As a result, claims 2-5, 7, 9-12, 22, 24-27, 29, 31-40 and 43 are not anticipated for at least the reasons discussed above regarding base claims 1 and 23. Appellant respectfully requests reversal of the rejection of claims 2-5, 7, 9-12, 22, 24-27, 29, 31-40 and 43.

C) The Rejection of Claims 8, 14, 30 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23.

i) The Applicable Law under 35 U.S.C. § 103

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The Federal Circuit has stated:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

In re Fine, 837 F.2d 1071; 5 USPQ2d 1596 (Fed. Cir.1988).

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007).

Further, conclusions of obviousness must be based on facts, not generality. *In re Warner*, 379 F.2d 1011, 1017 (C.C.P.A. 1967); *In re Freed*, 425 F.2d 785, 787 (C.C.P.A. 1970). In fact, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. The Federal Circuit has stated that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn,* 441 F. 3d 977, 988 (Fed. Cir. 2006), citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir.2002); 72 FR 57527-28 (Oct. 10, 2007).

Moreover, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn,* 441 F. 3d 977, 988 (Fed. Cir. 2006). This was recently echoed by the U.S. Supreme Court in *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.).

ii.) The Application of 35 U.S.C. § 103(a) to the Rejected Claims

Claims 8, 14, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23. Claims 8 and 14 depend from claim 1 and claims 30 and 36 depend from claim 23. These dependent claims inherit the elements of their respective base claims, including elements directed to sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; and in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As argued above, Gatto does not disclose these elements. As a result, claims 8, 14, 30 and 36 include, through inheritance from their respective base claims, elements not taught by Gatto. Therefore there are differences between claims 8, 14, 30 and 36 and Gatto. Thus the claims are not obvious in view of Gatto. Appellant respectfully requests reversal of the rejection of claims 8, 14, 30 and 36.

D) The Rejection of Claims 15-17 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over Gatto in view of Letovsky

Claims 15-17 and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23 in view of Letovsky. Claims 15-17 depend from claim 1 and claims 37-39 depend from claim 23. These dependent claims inherit the elements of their respective base claims, including elements directed to sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; and in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As argued above, Gatto does not disclose these elements. Additionally, Appellant has reviewed Letovsky and can find no teaching or suggestion of sending service information for a cashless gaming service from the cashless gaming service to a

discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; or in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As a result, claims 15-17 and 37-39 include, through inheritance from their respective base claims, elements not taught by either Gatto or Letovsky. Therefore there are differences between claims 15-17 and 37-39 and the combination of Gatto and Letovsky. Thus the claims are not obvious in view of the combination. Appellant respectfully requests reversal of the rejection of claims 15-17 and 37-39.

E) The Rejection of Claims 20-21 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Gatto in view of Oberberger

Claims 20-21 and 41-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claims 1 and 23 in view of Oberberger. Claims 20-21 depend from claim 1 and claims 41-42 depend from claim 23. These dependent claims inherit the elements of their respective base claims, including elements directed to sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; and in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As argued above, Gatto does not disclose these elements. Additionally, Appellant has reviewed Oberberger and can find no teaching or suggestion of sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; or in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As a result, claims 20-21 and 41-42 include, through inheritance from their respective base claims, elements not taught by either Gatto or Oberberger. Therefore there are differences between

claims 20-21 and 41-42 and the combination of Gatto and Oberberger. Thus the claims are not obvious in view of the combination. Appellant respectfully requests reversal of the rejection of claims 20-21 and 41-42.

F) The Rejection of Claim 44 under 35 U.S.C. § 103(a) as being unpatentable over Gatto taken with Bowman-Amuah

Claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto as applied to claim 43 taken with Bowman-Amuah. Claim 44 depends indirectly from claim 23 (through claim 43) and therefore inherits the elements of claim 23, including elements directed to sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network, determining by the discovery agent if the cashless gaming service is authentic and authorized and in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As argued above, Gatto does not disclose these elements. Additionally, Appellant has reviewed Bowman-Amuah and can find no teaching or suggestion of sending service information for a cashless gaming service from the cashless gaming service to a discovery agent on the gaming network; determining by the discovery agent if the cashless gaming service is authentic and authorized; or in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network. As a result, claim 44 includes, through inheritance from claim 23, elements not taught by either Gatto or Bowman-Amuah. Therefore there are differences between claim44 and the combination of Gatto and Bowman-Amuah. Thus claim 44 is not obvious in view of the combination. Appellant respectfully requests reversal of the rejection of claim 44.

SUMMARY

For the reasons argued above, claims 3-5, 8, 25-27, 30 and 44 were not properly rejected under 35 U.S.C. § 112. Additionally claims 1-5, 7, 9-12, 22-27, 29, 31-40 and 43 were not properly rejected under 35 U.S.C. § 102(b) for anticipation by Gatto. Furthermore, claims 8, 14-17, 20-21, 30, 36-39, 41-42 and 44 were not properly rejected under 35 U.S.C § 103(a) as being obvious.

It is respectfully submitted that the claims are neither anticipated nor obvious in view of the cited art and that the claims are patentable over the cited art. Reversal of the rejections and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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Date July 17, 2009 By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17 day of July 2009.

Rodney L. Lacy
Name

Signature

8. CLAIMS APPENDIX

1. A method for providing a cashless gaming service in a gaming network including gaming machines, the method comprising:

sending service information for the cashless gaming service from the cashless gaming service to a discovery agent on the gaming network, wherein the cashless gaming service provides electronic funds transfer for one or more of a plurality of gaming machines on the gaming network, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game;

determining by the discovery agent if the cashless gaming service is authentic and authorized;

in response to determining that the cashless gaming service is authentic and authorized, publishing the service information to a service repository to make the cashless gaming service available on the gaming network;

receiving by the discovery agent a discovery request for the location of the cashless gaming service from a gaming client on a gaming machine of the plurality of gaming machines;

using the service information for the cashless gaming service to register the gaming client with the cashless gaming service;

verifying that the gaming client is authorized to utilize the cashless gaming service; and

processing one or more service requests between the gaming client and the cashless gaming service, said service requests conforming to an internetworking protocol.

2. The method of claim 1, wherein the cashless gaming service comprises a web service.

3. The method of claim 2, wherein the service request is formatted according to a service description language.

4. The method of claim 3, wherein the service description language is a Web Services Description Language (WSDL).

5. The method of claim 2, wherein the cashless gaming service is registered in a UDDI registry.

7. The method of claim 1, wherein the gaming client comprises a service provider.

8. The method of claim 1, wherein the service request comprises an HTTP request encapsulating an OFX message.

9. The method of claim 1, wherein the service request comprises a request to establish a new account.

10. The method of claim 1, wherein the service request comprises a request to modify details for an account.

11. The method of claim 1, wherein the service request comprises a request to close an account.

12. The method of claim 1, wherein the service request comprises a request to provide details for an account.

13. The method of claim 1, wherein the service request comprises a request to obtain an account balance.

14. The method of claim 1, wherein the service request comprises a request to obtain a list of transactions associated with an account.

15. The method of claim 1, wherein the service request comprises a request to deposit funds into an account.

16. The method of claim 15, further comprising electronically transferring funds from an external account into the account.

17. The method of claim 16, further comprising obtaining authorization prior to electronically transferring funds.

18. The method of claim 1, wherein the service request comprises a request to withdraw funds from an account.

19. The method of claim 18, further comprising transferring the withdrawn funds as a playable credit on a gaming machine.

20. The method of claim 1, wherein the service request comprises a request to deposit promotional credits into an account.

21. The method of claim 1, wherein the service request comprises a request to withdraw promotional credits from an account.

22. The method of claim 1, further comprising authenticating the gaming client to determine if the gaming client is authorized to receive cashless gaming services.

23. A gaming network system, the gaming network system comprising:

a plurality of gaming machines communicably coupled to the gaming network, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game;

a cashless gaming service communicably coupled to the gaming network and operable to provide electronic funds transfer for the plurality of gaming machines on the gaming network,

a discovery agent communicably coupled to the gaming network, wherein the discovery agent is operable to:

receive service information from the cashless gaming service,

determine if the cashless gaming service is authentic and authorized for the gaming network, and

publish the service information to a service repository to make the cashless gaming service available on the gaming network;

wherein at least one gaming client on a gaming machine of the plurality of gaming machines communicably coupled to the gaming network is operable to issue a request for the location of the cashless gaming service to the discovery agent and use the service information received from the discovery agent to issue a registration request to the cashless gaming service; and

further wherein the cashless gaming service is further operable to:

receive the registration request from the gaming client; and

process one or more service requests between the gaming client and the cashless gaming service, said service requests conforming to an internetworking protocol.

24. The gaming network system of claim 23, wherein the cashless gaming service comprises a web service.

25. The gaming network system of claim 23, wherein the service request is formatted according to a service description language.

26. The gaming network system of claim 25, wherein the service description language is a Web Services Description Language (WSDL).

27. The gaming network system of claim 23, wherein the cashless gaming service is registered in a UDDI registry.

29. The gaming network system of claim 23, wherein the gaming client comprises a service provider in the gaming network.

30. The gaming network system of claim 23, wherein the service request comprises an HTTP request encapsulating an OFX message.

31. The gaming network system of claim 23, wherein the service request comprises a request to establish a new account.

32. The gaming network system of claim 23, wherein the service request comprises a request to modify details for an account.

33. The gaming network system of claim 23, wherein the service request comprises a request to close an account.

34. The gaming network system of claim 23, wherein the service request comprises a request to provide details for an account.

35. The gaming network system of claim 23, wherein the service request comprises a request to obtain an account balance.

36. The gaming network system of claim 23, wherein the service request comprises a request to obtain a list of transactions associated with an account.

37. The gaming network system of claim 23, wherein the service request comprises a request to deposit funds into an account.

38. The gaming network system of claim 23, wherein the cashless gaming service is further operable to electronically transfer funds from an external account into an account.

39. The gaming network system of claim 38, wherein the cashless gaming service is further operable to obtain authorization prior to electronically transferring funds.

40. The gaming network system of claim 23, wherein the service request comprises a request to withdraw funds from an account.

41. The gaming network system of claim 23, wherein the service request comprises a request to deposit promotional credits into an account.

42. The gaming network system of claim 23, wherein the service request comprises a request to withdraw promotional credits from an account.

43. The gaming network system of claim 23, further comprising an authentication service operable to authenticate the gaming client to determine if the gaming client is authorized to receive cashless gaming services.

44. The gaming network system of claim 43, wherein the authentication service includes a LDAP authentication service.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.